

MARKED-UP VERSION OF AMENDED CLAIM

19. (amended) The method of claim 18 [1], wherein a search key is used for retrieving the data from said databases.

REMARKS

Claims 11 through 27 continue to be in the case.

Claims 11-27 remain pending for examination.

Claim 19 is being amended.

The Office Action gives a Response to Arguments of the applicants.

2. The declaration will remain objected to until Applicant submits a proper substitute declaration.

A new inventor declaration accompanies this response.

3. Applicant states that six figures were submitted with the "amendment dated June 12, 2000" (Page 8 of Applicant's response); however, the present application was not even filed until September 8, 2000. There are no drawings present in the instant application. Please submit drawings in response to the present Office Action.

Applicants are submitting six figures together with the present response. In addition, a section with a Brief Description of the drawings and a revised section of detailed description now with the drawing numbers is being submitted.

4. In response to Applicant's argument regarding the incorporation of hyperlinks in the specification (Page 8 of Applicant's response), the objection to the specification is maintained because MPEP § 608.01 prohibits even printed versions of hyperlinks in the specification. Please amend accordingly.

Applicants respectfully disagree. Applicants did not argue that hyperlinks were appropriate in the description. Applicants noted that it is not clear to them what would represent an embedded hyperlink in the paper version and consequently no amendment was made. It is still not clear where the alleged hyperlink is present in the specification.

5. The previously pending claim objections are withdrawn in response to Applicant's claim amendments.

Applicants gratefully acknowledge the withdrawal of claim objections.

6. All rejections of the claims under 35 U.S.C. 112, 2nd paragraph are withdrawn (in response to Applicant's claim amendments), except for the rejection of claim 19 regarding its dependency from cancelled claim 1.

Claim 19 is being amended to render claim 19 now dependent on claim 18.

7. Applicant's arguments filed July 23, 2002 regarding the rejection under 35 U.S.C. 103(a) have been fully considered but they are not persuasive. More specifically, Applicant argues the following:

“Thus, claim 18 requires providing a presentation with price comparison of local merchants to a prospective buyer. In contrast Ziff-Davis 12 will bring computer buyers and sellers together in an interactive one stop shopping environment. There is nothing in Ziff-Davis about a presentation of a price comparison of local merchants where the products can be picked up afterwards. (Page 14 of Applicant's response).”

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Claim 18 stands rejected over Ziff-Davis in view of NetDynamics. It is the combination of these two references over which the claimed invention has been deemed obvious. Applicant has ignored the teachings of NetDynamics altogether; therefore, Applicant's arguments are non-persuasive.

Applicants respectfully request reconsideration. Ziff-Davis teaches in paragraph 4 that their "NetBuyer is designed to quickly and easily guide users through the entire buying process" without going to a local store.

In clear contrast, NetDynamics states in paragraph 1, that they move their "entire catalog onto the Internet by using NetDynamics' product, enabling customers to shop and buy goods online." Paragraph 6 says that customers will be enabled "to check to see if a product they want is available at their local Service Merchandise store."

Applicants respectfully submit that ZiffDavis and NetDynamics agree not to provide any price comparison between local stores and they also agree not to direct a buyer to a local store of the choice of the buyer.

Applicants respectfully submit that where two references agree not to do what applicants claim, then any combination of such references will be even less suggestive of the disclosure and claims of the applicants.

All objections and rejections maintained from the previous Office Action (paper no. 6) are reproduced below for Applicant's convenience.

Declaration

8. The declaration is defective. A new declaration in compliance with 37 CFR 1.67(x) identifying this application by application number and filing date is required.

See MPEP §§ 602.01 and 602.02.

The declaration is defective because it appears that neither of the inventors signed the declaration. Instead, "Sd--" is written on the signature lines of both inventors. Please submit a substitute declaration with both inventors' signatures.

A properly executed declaration is submitted with the instant response.

Drawings

9. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. Furthermore, the specification should be amended to make reference to the drawing(s) and all depicted reference numerals. No new matter may be introduced in the required drawing(s).

Applicants are submitting copies of the drawings which had been previously submitted in the parent application.

The Office Action refers to the Specification.

10. The disclosure stands objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Applicants are unaware of the hyperlink in the printed specification. Applicants kindly request to be informed on which page and at which line the hyperlink can be found and what characters make up the hyperlink.

The Office Action refers to Claim Rejections - 35 USC § 112.

12. Claim 19 is dependent from claim 1, but claim 1 is cancelled; therefore, for examination purposes, claim 19 is assumed to be dependent from claim 18 instead. Appropriate correction is required.

The present amendment renders claim 19 dependent on claim 18.

The Office Action refers to Claim Rejections - 35 USC § 103.

14. Claims 11-27 stand rejected under 35 U.S.C. 103(x) as being unpatentable over "Ziff-Davis Signs Up 189 Advertisers for the Coming Launch of Its Computer Shopper NetBuyer Web Site" (herein referred to as Ziff-Davis) in view of "Service Merchandise Uses NetDynamics to Move Its Entire Catalog Onto the Internet" (herein referred to as NetDynamics).

It appears important in this context to keep in mind that Ziff-Davis and NetDynamics have completely different goals: Ziff-Davis wants to set up a web site to provide net advertising and net sales to a plurality of merchants and NetDynamics wants to put the Service Merchandise catalog on the web with a possibility for a buyer to reserve a catalog item for pick-up in a local Service Merchandise store.

Ziff-Davis according to the Office Action discloses a method for presenting a price comparison to a prospective buyer comprising:

[Claim 11] collecting information from a plurality of merchants relating to data concerning products and respective price information (3, 12);
storing the information into records of a database (3, 12);

-sorting the information relative to products based on the database (3, 12);
presenting the information in a plurality of records to the prospective buyer
(3, 12).

Applicants respond:

[Claim 11 requires] collecting information from. a plurality of merchants relating to data concerning products and respective price information storing the information into records of the database Ziff-Davis in paragraph 7, line 3, states "As part of the charter agreement, advertisers have committed to keeping their product specifications and pricing current, and to quickly responding to online inquiries and product orders from NetBuyer users." This illustrates the advertisers control the information and Ziff-Davis is not collecting the information from a plurality of merchants. This also restricts the number of vendors to a select set of advertisers. The proposed claim includes all merchants and proactively collects information from all merchants that are stored in a database.

-sorting the information relative to products based on the database

Applicants respond:

Ziff-Davis does not address sorting of the information. The proposed patent explicitly sorts the information relative to products.

-presenting the information. in a plurality of records to the prospective buyer

Applicants respond:

Ziff-Davis does not address presenting the information. The proposed claim explicitly presents the information in a plurality of records to the prospective buyer.

The Office Action continues:

[Claim 12] collecting the information from sales circulars, advertised specials, sales promotions, merchants (3, 7, 12);

collecting information relating to merchant name, merchant address, product description, model number, regular price, sales price, coupons, rebates, colors, or sizes (3, 7, 12);

entering attributes into a search key (3, 12);

entering geographical region, postal code, town name, county name, state name, product name, product category, model number, product description, price, product features, or brand name into the search key (3, 12).

Applicants respond:

[Claim 12 requires] collecting the information from sales circulars, advertised specials, sales promotions, merchants collecting information relating to merchant name, merchant address, product description, model number, regular price, sales price, coupons, rebates, colors, or sizes

Ziff-Davis states "Vendors actively participate in building NetBuyer's fully searchable shopping database which, at launch, will include specifications for more than 42,000 products." Ziff-Davis further states "Computer Shopper NetBuyer offers three advertising options: traditional ad banners,

direct vendor product listings to appear in the shopping database, and weekly manufacturer or reseller 'Special Offers.' For the three-month charter period that will end December 31, advertisers can purchase charter ad banners at 1/3 off the rate-card price (limited availability), and secure their first 200 product listings for free. In addition, they can opt to purchase a limited inventory of weekly Special Offers, or pop-up ads that highlight special, limited-time offers. Four Special Offers are available for each of the 16 NetBuyer product categories each week." Ziff-Davis does not disclose the type of information being collected. The Ziff-Davis 'Special Offers' refer to pop-up ads that can be delivered by the advertisers. The proposed patent describes the type of information to be collected and teaches that the coupons and rebates are a part of information being collected.

[Claim 12 continues] entering attributes into a search key

Ziff-Davis states "Vendors actively participate in building NetBuyer's fully-searchable shopping database which, at launch, will include specifications for more than 42,000 products. NetBuyer was designed to enable buyers to quickly and easily identify the products that match their needs, providing side-by-side product comparisons, vendor special offers, and editorial buying advice." ZiffDavis does not disclose anything about entering attributes into a search key. The proposed patent uses attributes to search the information.

[Claim 12 continues] entering geographical region, postal code, county name, county name, state name, product name, product category, model number, product description, price, product features, or brand name into the search key

Ziff-Davis states "Vendors actively participate in building NetBuyer's fully-searchable shopping database which, at launch, will include specifications for more than 42,000 products. NetBuyer was designed to enable buyers to quickly and easily identify the products that match their needs, providing side-by-side product comparisons, vendor special offers, and editorial buying advice." ZiffDavis does not disclose anything about types of attributes that are entered into a search key. The proposed claim describes the types of attributes to search the information.

The Office Action continues:

[Claim 13] entering attributes into a search key (3, 12);

 sorting the database according to merchant name, product name or model number (3, 12);

 entering data for merchants offering a specific product into the database, wherein the data includes merchant name, product description, sales price, product description, sales price, coupons or rebates (3, 6, 7, 12);

 providing access to the database through a browser interface (3 -- "web based").

Applicants respond:

[Claim 13 states] sorting the database according to merchant name, product name or model number

Ziff-Davis states "NetBuyer was designed to enable buyers to quickly and easily identify the products that match their needs, providing side-by-side product comparisons, vendor special offers, and editorial buying advice." Ziff-Davis does not disclose anything about how the database may be sorted.

The proposed claim 13 describes the multiple options for sorting the database.

[Claim 13 continues:] entering data for merchants offering a specific product into the database, wherein the data includes merchant name, product description, sales price, coupons or rebates

Ziff-Davis states "Vendors actively participate in building NetBuyer's fully-searchable shopping database which, at launch, will include specifications for more than 42,000 products." Ziff-Davis further states "Computer Shopper NetBuyer offers three advertising options: traditional ad banners, direct vendor product listings to appear in the shopping database, and weekly manufacturer or reseller 'Special Offers.' For the three-month charter period that will end December 31, advertisers can purchase charter ad banners at 1 /3 off the rate-card price (limited availability), and secure their first 200 product listings for free. In addition, they can opt to purchase a limited inventory of weekly Special Offers, or pop-up ads that highlight special, limited-time offers. Four Special Offers are available for each of the 16 NetBuyer product categories each week." Ziff-Davis does not disclose the type of information being collected. The Ziff-Davis 'Special Offers' refer to pop-up ads that can be delivered by the advertisers. The proposed patent describes the type of information to be collected and teaches that the coupons and rebates are a part of information being collected.

[Claim 13 continues:] providing access to the database through. a browser interface (web-based)

Ziff-Davis states "Ziff-Davis Publishing's Computer Shopper NetBuyer is the Web-based companion to Computer Shopper magazine, the bible of the computer industry's direct sales channel." The proposed patent also discloses

the input and output interfaces to the apparatus are provided via the World Wide Web, Email, voice telephony, or video telephony.

As per Claim 11, Ziff-Davis according to the Office Action does not explicitly teach that merchant products compared and presented to customers on the Internet can be ordered online and picked up from a local store; however, NetDynamics makes up for this deficiency.

NetDynamics provides the following services through their affiliates: Included with the expanded catalog are NetDynamics applications enabling customers to check to see if a product they want is available at their local Service Merchandise store. Customers will be able to reserve the item online before visiting the store to pick it up...

Rinat explained that all of this is made possible because NetDynamics enables the development of Web applications that tie into extensive data sources. In the case of Service Merchandise, these data sources include product listings, price, and availability. NetDynamics enables Service Merchandise customers to access this information over the Internet and then to purchase it through a secure transaction. (6, 8)

Applicants respond:

The announcement that Service Merchandise Uses NetDynamics to Move its Entire Catalog Onto the Internet NetDynamics states "Service Merchandise and NetDynamics Inc. today announced that Service Merchandise is moving its entire catalog onto the Internet by using NetDynamics' product, enabling customers to shop and buy goods online." This Business Wire press release is specific to Service Merchandise products that can be viewed and

purchased online by the customers and picked up at a store. In effect, this is a web-based catalog of Service Merchandise products.

According to the Office Action both Ziff-Davis and NetDynamics are concerned with providing a convenient Internet shopping experience to the customers; NetDynamics takes this concept one step further and fulfills many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the step of collecting information from a plurality of merchants relating to data concerning products in store locations and respective price information, wherein the prospective buyer is capable of visiting the store locations, with Ziff-Davis' Internet shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Applicants respectfully disagree. While Ziff Davis provide product and price comparison, they expressly say in paragraph 4 that they guide the shopper through the entire buying process. This clearly expresses that according to Ziff-Davis nothing is to be added to the buying process of Ziff-Davis and it is respectfully urged that the person of ordinary skill in the art better accept the suggestion in Ziff-Davis that Ziff-Davis guides users through the entire buying process and that nothing else and in particular no NetDynamics features are needed.

Regarding claim 12, Ziff-Davis conveys the importance of allowing customers to search for products that meet the individual needs of each customer (3, 4); however, Ziff-Davis does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort Ziff-Davis' product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

Where Ziff Davis guides the user through the entire buying process (Ziff-Davis paragraph 4), it is not understood where the suggestion comes from to sort according to price and it is believed that it is clear hindsight in view of applicants' invention.

As per claim 13, the Ziff-Davis-NetDynamics combination teaches the concept of comparing desired products from different merchants via the Internet, ordering products online, and then picking up the products at a local merchant (as discussed above).

Applicants respectfully disagree. Ziff-Davis and NetDynamics agree not to provide price comparisons of local merchants and not to enable a buyer to select among local competitive stores. Ziff-Davis clearly states that their proposal covers the entire buying process. It is not appropriate in an Office Action to contradict the express statements of the references.

The Office Action continues that in order for such a system to be operational, a customer must specify his/her location so that stores truly

local to the customer can be identified. The Examiner submits that the use of a state to identify one's location (thereby implying one's local region) is old and well-known in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to request that a prospective buyer specify a state in which a desired product will be searched for and then pick-up, if available, as part of the Ziff-Davis-NetDynamics combination in order to allow a prospective buyer to quickly learn if desired products are available for pick-up locally (instead of forcing the prospective buyer to read through useless product inventory data from stores in remotely located states).

Applicants take exception, the indication of a state abbreviation clearly will in most cases not indicate local availability. Nobody in Buffalo would consider New York City local and nobody in San Francisco would consider San Diego to be local. Apart from that, neither Ziff-Davis nor NetDynamics employ the State abbreviation for directing to local merchants, this is solely the concept of the present Examiner.

Further, the notion of sorting a database by sales price was addressed above as well; therefore, the concept of presenting products in an ascending order based on sales price (as part of the Ziff-Davis-NetDynamics combination) would also have been obvious to one of ordinary skill in the art at the time of Applicant's invention in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

Applicants respectfully disagree. Where Ziff-Davis according to paragraph 4 "quickly and easily guide users through the entire buying

process", it is very clear that no additional sorting is to be part of the Ziff-Davis process. Where there is quick and easy guiding, no quicker narrowing down is contemplated.

Finally, as discussed above, the concept of sorting data provides a convenience to someone reviewing the sorted data; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow a prospective buyer to sort product data as seen fit by the buyer (e.g., based on price, merchant name, etc.) in order to facilitate a quicker review of only the most pertinent products fitting the buyer's needs.

Applicants urge that both the telephone and the light bulb provide a big convenience to anybody employing them, nevertheless they were eminent invention and clearly not obvious even in view of their extremely high convenience. Thus, on the contrary, the convenience associated with the present invention method suggests unobviousness, since both Ziff-Davis and NetDynamics fail to set forth the specific steps of the applicants.

Regarding claim 14, Ziff-Davis does not explicitly disclose the use of a unique address corresponding to a geographical area-product combination; however, the Examiner asserts that the assignment of a unique web address corresponding to a particular geographical region is old and well-known in the art. This technique is helpful in reducing Internet traffic at a given web site. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to map the merchant and product data (of the Ziff-Davis-NetDynamics combination) to a unique address and present comparison data for a unique geographical

area-product pair to the prospective buyer via this unique address in order to minimize Internet traffic build-up at a given web site. This will speed up each prospective buyer's Internet connection, thereby providing a more pleasant online shopping experience.

Ziff-Davis and NetDynamics agree not to provide product and price comparisons of local competitive merchants. In view of this lack of endeavor in the two references, there is no motive within the four corners of the references to do what the Examiner now proposes.

In reference to claim 15 and as discussed above, NetDynamics teaches the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed.

Applicants respectfully disagree. According to NetDynamics, Paragraph 6, "Customers (of Service Merchandise) will be able to reserve the item online before visiting the (Service Merchandise) store to pick it up." No local store of a merchant is checked, everything occurs within the bounds of the Service Merchandise chain. Thus NetDynamics proposes a reservation system for a local chain store, whereas the present invention addresses a product and price competitive system between a plurality of merchants.

The Office Action continues that again, this shopping arrangement provides for the fulfillment of many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the

steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed with Ziff-Davis' Internet shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

The position of Ziff-Davis, paragraph 4, is that they "quickly and easily guide users through the entire buying process" and therefore nothing else is to be reaped. Where a reference suggests nothing else is to be reaped, a person of ordinary skill in the art will not be looking for reaping something. Applicants urge that the hindsight desirability of the present invention steps does not indicate obviousness, on the contrary, the more desirable the steps of the applicants are, the more they furnish a basis of patentability of applicants' invention.

Regarding claim 16, both Ziff-Davis and NetDynamics facilitate the payment of an ordered product via the Internet; however, neither reference expressly teaches payment through the use of either a registration token or a credit card number. The Examiner asserts that it is old and well-known in the art to make payments via the Internet using either a registration token or a credit card number; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate the use of a registration token or a credit card number to order and pay for a product via the Internet (as part of the Ziff-Davis-NetDynamics combination) in order to facilitate convenient and secure Internet payments.

Further, since the ZiffDavis-NetDynamics combination teaches the online reservation of an item before picking it up, the ability to make payment via the Internet provides extra assurance to the merchant that the reserved item will be picked up by a customer. In other words, reserved items are confirmed sales as opposed to items merely put on hold that may or may not ever be picked up and paid for by the customer.

Applicants respectfully disagree. Neither Ziff-Davis nor NetDynamics propose the payment solution and purchase guaranty required according to claim 16. The desirability of the steps of claim 16 are no basis for holding this steps obvious in view of the lack of teaching in both Ziff-Davis and NetDynamics.

[Claim 17] Claim 17 recites limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Applicants repeat the considerations presented above.

[Claims 18-22] Claims 18-22 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Applicants repeat the considerations presented above.

[Claims 23-27] Claims 23-27 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Applicants reiterate the considerations presented above.

Applicants wish to present the following further considerations:

NetBuyer is an extension of Ziff-Davis's existing Computer Shopper magazine service. According to the news release, "Computer Shopper

NetBuyer offers three advertising options: traditional ad banners, direct vendor product listings to appear in the shopping database, and weekly manufacturer or reseller 'Special Offers.' For the three-month charter period that will end December 31, advertisers can purchase charter ad banners at 1/3 off the rate-card price (limited availability), and secure their first 200 product listings for free." Evidently, Computer Shopper NetBuyer product listings are the result of product placement advertising by the direct channel computing vendors and is just another form of advertising.

The present amendment is intended to present claims which are deemed to be in better form for appeal.

The present amendment is deemed to remove and/or simplify issues which would otherwise require consideration in an appeal.

The present amendment is believed not to present any new issues since the claims are substantially based on previously presented claims and since such limitations had been individually submitted earlier and had been considered earlier.

It is submitted that the amendment is a bona fide attempt to advance the prosecution by amendments to the claims seeking to overcome rejections based on the applied prior art and/or rejections under 35 U.S.C. 112.

It is submitted that the present amendment complies with observations made in the Final Rejection.

Reconsideration of all outstanding rejections is respectfully requested.

Entry of the present amendment is respectfully requested. All claims as presently submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,

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Attorney's Docket: FRB208

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